

Remarks

The undersigned's Remarks are preceded by related comments of the Examiner, presented in small bold-faced type.

Claim Rejections - 35 USC § 112

Claims 7, 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 7, since pager can take many shapes and sizes, it is unclear what dimensions are being claimed.

The rejection in light of § 112 ¶ 2 is respectfully traversed. The term "pager," as used in claim 7, is a term well understood by one of skill in the art at the time the application was filed and the use of the term "pager-sized" would encompass the "many shapes and sizes" referenced by the Examiner. Absent a showing of relevant prior art by the Office, there is no requirement that applicant limit the claims to particular shapes or sizes of such devices. The Examiner is specifically referred to MPEP § 2173.04 which states:

§ 2173.04 Breadth Is Not Indefiniteness

Breadth of a claim is not to be equated with indefiniteness. In re Miller, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). ...

The Office's rejection due to use of a term "pager" indicating a breadth of sizes is clearly indicated as inappropriate under MPEP 2173.04. It is respectfully requested that this rejection be withdrawn.

Claim Rejections - 35 USC § 103

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Humble'136 in view of Ito et al.

Humble discloses a checkout station configured for self-checkout by customers of items for purchase (50); a supervisory terminal is configured to conduct supervisory activities to administer the operation of the checkout station 28, e.g. missing codes inputted into system is read as supervisory activity); However, Humble fails to teach a controller operatively coupling a plurality of supervisory terminals to the checkout station, wherein said controller is configured to enable administration of the checkout station by multiple ones of the supervisory terminals.

But, Ito et al. do disclose a controller (30) operatively coupling a plurality of supervisory terminals (32, 33) to a controlled device (fig. 12 item 33), wherein said controller is

configured to enable administration of the controlled devices by multiple ones of the supervisory terminals.

As further explained below, the Examiner's rejection is respectfully traversed. Neither Humble nor Ito, alone or in combination, disclose or suggest a customer self-checkout system for processing items for purchase, that includes a checkout station configured for self-checkout by customers of items for purchase; a plurality of supervisory terminals configured to conduct supervisory activities administering operation of the checkout station; and a controller operatively coupling the plurality of supervisory terminals to the checkout station, wherein said controller is configured to enable administration of the checkout station by multiple ones of the supervisory terminals.

Ito Is Not Analogous Prior Art and Is Not A Proper Reference On Which To Base a § 103 Rejection

Generally speaking, Humble, like the present application, relates to the field of self-checkout systems. Ito, on the other hand, relates to an entirely different field – i.e., the control of illumination systems. These two fields bear no reasonable relationship to each other and are not analogous. It is well settled that to rely on a reference under 35 U.S.C. § 103, it must be analogous prior art. MPEP § 2141.01(a) makes this clear and states, *inter alia*:

"In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992) ("A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem."); * *Wang Laboratories Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993); and *State Contracting & Eng'g Corp. v. Condotte America, Inc.*, 346 F.3d 1057, 1069, 68 USPQ2d 1481, 1490 (Fed. Cir. 2003) (where the general scope of a reference is outside the pertinent field of endeavor, the reference may be considered analogous art if subject matter disclosed therein is relevant to the particular problem with which the inventor is involved)<.

MPEP 2141.01(a) makes clear that the Office, in combining the Ito and Humble references, has the burden of showing that the combined references are analogous prior art. The Office has not met this burden as the Office has provided no objective evidence that one of skill

in the art of designing point of sale self-checkout systems would consult references in the field of lighting control in order to designs a sophisticated computer control systems and software to operate a self-checkout system. Indeed, it is respectfully submitted that the Ito reference would not have “commended itself to an inventor’s attention in considering [the problem of control of a self-checkout system]” as is required by MPEP § 2141.01(a). Further note is made of the fact that the Humble reference and Ito reference bear different U.S. and international classifications and are located in different Fields of Search. MPEP 2141.01(a) makes clear that the fact that the references bear different classifications is evidence that the references are nonanalogous.

In summary, it is respectfully submitted that the Office has not met its burden of showing that the combined references are analogous prior art and, further, it is submitted that self-checkout systems (Humble) and lighting control (Ito) are simply not analogous.

For at least the foregoing reasons, the combination of Ito and Humble is improper and it is respectfully requested that the rejection of claims in light of this combination be withdrawn and the claims allowed.

The Combination of Humble and Ito do not teach the Limitations of the Claims

Claim 1 recites a customer self-checkout system for processing items for purchase. The system includes a checkout station configured for self-checkout by customers of items for purchase; a plurality of supervisory terminals configured to conduct supervisory activities administering operation of the checkout station; and a controller operatively coupling the plurality of supervisory terminals to the checkout station, wherein said controller is configured to enable administration of the checkout station by multiple ones of the supervisory terminals.

Even if some teaching could be found to combine lighting control systems with self-checkout systems, the particular combination of Ito and Humble cited by the examiner still does not teach the combination of elements found in claim 1 and, accordingly, the rejection of claim 1 in light of Humble and Ito is improper. Claim 1 requires that there be a plurality of supervisory terminals configured to conduct supervisory activities administering operation of self-checkout stations and a controller operatively coupling the plurality of supervisory terminals to the checkout stations, wherein said controller is configured to enable administration of the checkout station by multiple ones of the supervisory terminals. In relying on the Ito reference, the Office

has suggested that the luminaries (33) controlled by Ito's control terminal (32) are somehow analogous to the self-checkouts system referenced in the claims of the present application. This is not the case. Ito's luminaries 33 are understood as being little more than light bulbs and, accordingly there is no suggestion that they can generate or respond to supervisory events or instructions or otherwise have a state requiring "supervisory activities" as required by the claims of the present application. Accordingly, Ito's control terminal 32 simply does not provide for "supervisory activities administering operation of the checkout station" as recited by claim 1 and would not teach or suggest a supervisory terminal in accordance with the invention recited by the claims of the present application.

For at least the additional reasons cited above, the rejection of claim 1 under § 103 in light of Humble and Ito is not supported and it is respectfully requested that the rejection be withdrawn and the claims allowed.

It would appear obvious to modify the system in Humble to include the controller 30 and plural supervisory terminals of Ito et al. because the motivation for this is set forth in Mumble in col. 2 to prevent bottlenecking of the system and thus the plural supervisory system of Ito et al. would do exactly that by allowing the other stations 28 to pick up the load at a point where the one station worker 28 becomes bottlenecked.

With regard to the Examiner's citation to col. 2 of Humble and the issue of "bottlenecking" the undersigned assumes that Examiner's reference is more specifically addressed to the bottlenecking issue discussed at col. 2, lines 42-45 (this appears to be the only direct reference to a "bottleneck" in column 2).

Contrary to the Office's suggestion, column 2 of Humble does not provide a motivation to combine Humble with Ito to provide for the supervisory control system as recited in the claims of the present application. Indeed, the cited column appears to suggest an opposite approach – i.e., that there be a single supervisory terminal connected to multiple self-checkout systems. The cited section of Humble appears to suggest little more than that the number of self-checkout systems attached to the supervisory terminal should be limited (e.g., to three) to solve bottlenecking issues. It is respectfully suggested that this teaches away from or, at best, is irrelevant to the issue of coupling multiple supervisory terminals to self-checkout station. It is further submitted that the Office's combination of Humble and Ito appears to be based on

impermissible hindsight reasoning. The application of such hindsight reasoning when combining references is not permissible. See, generally, MPEP § 2142.

For at least the additional reason that the Office has not shown a proper motivation to combine Humble and Ito, it is respectfully requested that the rejection of claim 1 be withdraw.

Conclusions

As further detailed above, and for at least the reasons that (i) Ito is not a proper reference on which to base a § 103 rejection; (ii) a combination of Humble and Ito do not teach or suggest all elements recited by the claims; and (iii) Humble col. 2 does not provide for a motivation to combine Humble and Ito, the rejection of claim 1 is not supported. It is submitted that claim 1 is allowable over the cited prior art and it is respectfully requested that the Examiner withdraw the rejection and allow the claim.

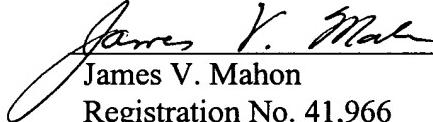
Claims 2-8 depend, directly or indirectly, on claim 1 and are patentable for at least the reasons set forth with respect to claim 1.

Claims 1-13 are now pending and believed to be in condition for allowance. Applicant respectfully requests that all pending claims be allowed.

Please apply any credits or excess charges to our deposit account number 50-0521.

Respectfully submitted,

Date: May 4, 2005



James V. Mahon
Registration No. 41,966
Attorney for Applicants

MAILING ADDRESS

Clifford Chance US LLP
31 West 52nd Street,
New York, NY 10019-6131